

REMARKS

Entry of this amendment and favorable reconsideration of this application are respectfully requested.

Claims 1, 2, 5, 7, 9, and 11-40 are pending in this application.

Claims 22, 25, 29, 31 and 40 had been objected to in the previous Office Action, Paper No. 15, Paragraph No. 6. Claims 22, 25, 29, 31 and 40 are amended as suggested by the examiner. These amendments which primarily correct typographical errors in the claims were inadvertently omitted from the previous response. It is respectfully submitted that entry of these amendments places the application in better condition for appeal, if an appeal becomes necessary.

Claims 1, 2, 5, 7-9, 11-16, 21, 23, 24, 27-34 and 39 have been rejected under 35 USC 102(e) as being anticipated by Cen et al U.S. Patent no. 6,428,799 (hereinafter referred to simply as “Cen”). In addition, claims 17-20, 22, 25, 26, 35-38 and 40 have been rejected under 35 USC 103(a) as unpatentable over Cen. These rejections are respectfully traversed.

In paragraph 9 of the Office Action it is asserted that applicant’s definition of the term “substantially anhydrous” should be examined as a product by process claim limitation and thus the same rejections of record are appropriate. Applicants respectfully disagree. The phrase “substantially anhydrous” is clearly not a process limitation. As noted at page 3, lines 3-7 of the specification, the term “substantially anhydrous” means that “no free water is added to the composition”. The definition of “substantially anhydrous” provided in applicants’ specification thus explains what is and what is not in

the composition and is not a process limitation. Essentially, the definition of substantially anhydrous dictates that the composition contains no free added water -- that water is not an ingredient in the formulation. The Federal Circuit recently addressed similar issues in 3M Innovative Properties v. Avery Dennison Corporation, No. 03-1203 (Fed. Cir. December 2, 2003) when it stated at page 11:

"In the specification, 3M clearly acted as its own lexicographer, and the definition provided requires only that the "two or more embossing patterns" be "superimposed." '930 patent, col. 2, ll. 1-2. Despite Avery's arguments to the contrary, the use of "superimposed" in this definition neither transforms claim 1 into a product-by-process claim nor even limits the scope of the claim to a serial method of manufacture; it describes only the structural relationship between the embossing patterns. See Webster's Third New International Dictionary 2294 (1993) (defining "superimposed" as "layered"). Furthermore, even words of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural sense, unless the patentee has demonstrated otherwise. See Hanzai v. United States Int'l Trade Comm'n, 126 F.3d 1473, 1479 (Fed. Cir. 1997) (concluding that "chemically engraved" was not a process term); Vanguard Prods. Co. v. Parker Hannifin Corp., 234 F.3d 1370, 1372 (Fed. Cir. 2000) (holding that the claim term "integral" describes a structural relation, not the particular manufacturing process related in the specification); cf. id. ("A novel product that meets the criteria of patentability is not limited to the process by which it was made." (citing 3 Donald S. Chisum, Chisum on Patents § 8.05, at 8-79 (2000)))."

Thus, the definition "substantially anhydrous" does not implicate a product by process limitation, but describes a characteristic of the claimed composition.

Turning now to the substance of the rejection, Cen fails to teach or suggest compositions that are substantially anhydrous as that term is used in the present claims. Rather than being substantially anhydrous, the Cen compositions referred to in the rejection each include free added water.

The rejection set forth in the previous Office Action specifically mentioned Examples 65, 66 and 67 of Cen. The formulations for these examples appear at column

61 of Cen. Water is the third ingredient in Part A of the applied Cen formulations. In example 65, 4.43% of free water is added and in each of Examples 66 and 67, 3.00% of free water is added. Thus, the Cen compositions are not substantially anhydrous as defined by Applicant.

In fact, many of the Cen examples affirmatively list water as a separate ingredient. In these examples, free added water is present. Other Cen examples do not list water as an ingredient. See, for example, Cen examples 59 – 64 at column 60. One or more of the ingredients that are specifically listed may have a certain amount of water e.g., as water of hydration. However, convention dictates that water not be listed as an ingredient on the list, since free water is not being added. In fact, with respect to one ingredient, i.e., Sancure 2710, in accordance with accepted convention, Cen provides a footnote to explain that water is present in that ingredient at a level of 30%. Again, because convention dictates that only the ingredients actually added to the formulation be listed in an ingredients list, Cen lists “polyurethane latex in 50% isopropanol” in the table containing examples 59-64, and clarifies in a footnote that the ingredient includes some water.

Thus, it must be concluded that when Cen lists water as an ingredient in a formulation, he is referring to free added water in accordance with the convention widely accepted by those skilled in the art. When Cen does not list water as an ingredient, there may perhaps be some water present, (such as water of hydration or already contained in an ingredient of the formulation), but no free added water has been added. When a listed ingredient includes water, the ingredient is listed by Cen (in accordance with the widely

accepted convention) and the components of the ingredient (including any water present) are noted in a footnote.

To the extent Cen is silent with respect to the source of water driven from the composition during preparation of “conditioning component for the articles” of the Cen disclosure (such as, for example, in the examples specifically mentioned in the rejection), the source of such removed water is irrelevant, provided free water was added as an ingredient during formulation. The presently claimed compositions include no free added water and are thus substantially anhydrous.

Nor is it seen where in Cen it is suggested that water can be excluded from the compositions disclosed therein. Rather, in Examples 65-67, Cen uses a polyacrylamide as a polymer gelling agent. However, Cen’s polymeric gelling agents form hydrogels in a conventional manner which involves the use of water or other aqueous medium and/or neutralizing the polymers. For example, at column 31, line 64 through column 36, line 3 Cen discusses the “Hydrogel Forming Polymeric Gelling Agents” useful in his products. In comparison, at page 6, lines 6-9 of Applicants’ specification it is noted that the ability to use a polyacrylamide without being dispersed in an aqueous media or neutralized is a surprising result of the present compositions. This surprising aspect of the present compositions is nowhere taught or suggested by Cen.

It is not surprising that Cen’s compositions are not the same as applicants’ compositions since the intended end uses of the compositions is quite different. Cen’s compositions are intended for application to a substrate to produce a substantially dry, disposable personal care article. Applicant’s compositions are intended for use as cosmetic or medicinal compositions for direct application to the skin of a user. While it

appreciated that the intended uses are not recited in the claims presently being examined, consideration of the intended uses is believed relevant to a consideration of what one skilled in the art reading Cen would or would not find to be obvious.

Because Cen does not teach or suggest compositions which are substantially anhydrous, withdrawal of the rejections of claims 1, 2, 5, 7-9 and 11-40 in view of Cen is respectfully requested.

Respectfully submitted,



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